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10/740,486

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. VANDERHYE

Appeal 2009-004151
Application 10/740,486
Technology Center 2600

Decided: March 5, 2010

Before, MAHSHID D. SAADAT, ROBERT E. NAPPI, and
ELENI MANTIS-MERCADER, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1, 3, 5-17, and 20-25.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part the Examiner's rejection of these claims.

INVENTION

The invention is directed to a method of producing a piece of artwork by controlling the colors of a color printer, printing out an image, and adding artistic elements. *See* Spec: 1-4. Claim 1 is representative of the invention and reproduced below:

1. A method of producing a piece of artwork using a computer-controlled color printer capable of printing at least three colors, comprising:
 - (a) inputting or selecting a multicolor image so that it is provided in the computer;
 - (b) selectively disabling one or more of the colors, while not disabling all of the colors besides black, of the printer to insure little or none of the one or more disabled colors is printed by the printer;
 - (c) with the printer, printing the non-disabled color or colors of the image onto a substrate; and then
 - (d) acting upon the substrate c) to add artistic elements to the substrate to produce an artwork.

REFERENCES

| | | |
|-------|--------------------|--|
| Abram | US 2002/0003631 A1 | Jan. 10, 2002 |
| Kohno | US 6,749,282 B2 | Jun. 15, 2004 (filed Feb. 22, 2001) |

¹ Claims 2, 4, and 18-19 were cancelled in an Amendment filed 11 October 2007.

REJECTIONS AT ISSUE

Claims 1, 3, 5-10, 12-17, and 20-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Abram. Ans. 3-14.

Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Abram in view of Kohno. Ans. 14.

ISSUES

Rejection of claims 1, 3, 5-10, 12-17, and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over Abram

Independent claims 1 and 24 and Dependent claims 3, 5-10, 12-17, 23, and 25

Appellant argues on page 7 of the Appeal Brief and pages 4-5 of the Reply Brief that the Examiner's rejection of claims 1, 3, 5-10, 12-17, and 23-25 is in error. Appellants argue that Abram does not disclose selectively disabling one or more of the colors, as required by independent claims 1 and 24. App. Br. 7; Reply Br. 4-5.

Thus, Appellant's contentions with respect to claims 1, 3, 5-10, 12-17, and 23-25 present us with the issue: Has that the Examiner erred in finding that Abram discloses selectively disabling one or more of the colors?²

² Appellant makes additional arguments regarding claims 1, 3, 5-10, 12-17, and 20-25. App. Br. 3-10; Reply Br. 1-6. We do not reach these additional issues since whether Abrams discloses selectively disabling one or more colors is dispositive of the case.

Independent claim 20

Appellant argues on pages 5-9 of the Appeal Brief and pages 4-6 of the Reply Brief that the Examiner's rejection of claim 20 is in error. Appellant argues that Abram does not disclose "a thermal inkjet printer having an active black inkjet cartridge and at least one active primary color inkjet cartridge." App. Br. 7. Appellant additionally argues that Abram does not disclose disabling 80-100% of the black or near black color from the ink cartridge and printing a substantially accurate representation of the image without 80-100% of the black or near black color. App. Br. 7; Reply Br. 4.

Thus, Appellant's contentions with respect to claim 20 present us with two issues: (1) Has the Examiner erred in finding that Abram discloses a thermal inkjet printer having an active black inkjet cartridge and at least one active primary color inkjet cartridge? (2) Has the Examiner erred in finding that Abram discloses disabling 80-100% of the black or near black color from the ink cartridge and printing a substantially accurate representation of the image without 80-100% of the black or near black color?

Dependent claim 21

Appellant argues on page 9 of the Appeal Brief that the Examiner's rejection of claim 21 is in error. Claim 21 depends upon claim 20 and contains similar limitations to claim 20. Appellant presents the same issues with respect to claim 20. App. Br. 9. Additionally, Appellant argues that Abram does not disclose applying acrylic paint to a portion of the substrate. App. Br. 9.

Thus, Appellant's contentions with respect to claim 21 present us with the same issue as claim 20 and the additional issue: Has the Examiner erred

in finding that Abram discloses applying acrylic paint to a portion of the substrate?

Dependent claim 22

Appellant argues on page 9 of the Appeal Brief that the Examiner's rejection of claim 22 is in error. Claim 22 depends upon claim 20 and contains similar limitations to claim 20. Appellant presents the same issues with respect to claim 20. App. Br. 9. Additionally, Appellant argues that Abram does not disclose utilizing 30 lb. matte paper. App. Br. 9.

Thus, Appellant's contentions with respect to claim 22 present us with the same issue as claim 20 and the additional issue: Has the Examiner erred in finding that Abram discloses utilizing 30 lb. matte paper?

*Rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over
Abram in view of Kohno*

Appellant argues on pages 10-11 of the Appeal Brief and page 6 of the Reply Brief that the Examiner's rejection of claim 11 is in error. Claim 11 is dependent upon claim 1 and contains similar limitations to claim 1. Appellant presents the same issue with respect to claim 1. App. Br. 10-11; Reply Br. 6. Thus, Appellant's arguments with respect to the Examiner's rejection of claim 11 presents us with the same issue as claim 1.³

³ Appellant makes additional arguments with respect to claim 11. App. Br. 10-11; Reply Br. 6. We do not reach these additional issues since the issue addressed with respect to claim 1 is dispositive of the case.

FINDINGS OF FACT

Appellant's Specification

1. Appellant's invention uses inkjet, laser printers, or any type of computer controlled color printer that prints in more than one color. Spec. 1:8-11.
2. In creating a final piece of art, many types of art techniques may be used to apply color and texture, including: using a paint brush to apply paint, using a palette knife to apply paint or wax, and incorporating foreign materials into artwork. All of these techniques are well-known in the art. Spec. 8:8-10.
3. Printers can use many types of substrates that receive and retain ink, including paper. Types of known papers include: twenty-four pound or greater bond wood paper, glossy photo paper, cotton hemp or flax paper, and thirty pound or greater matte finish photo paper. Spec. 7-8.

Abram

4. Abram discloses producing coloring book images from digital images. ¶ [0002].
5. Digital images are uploaded to a client. A line-art image is rendered from the digital image and a coloring book image is formatted from the line-art image. The coloring book image is then printed. ¶ [0025].
6. Color samples are generated from the digital image and either a fixed or programmable palette of colors can be assigned to areas of the coloring book. A color-by-numbers coloring book image may be

created by printing index numbers and a color that corresponds to a sample color on the coloring book image. ¶ [0028].

PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). “[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

On the issue of obviousness, the Supreme Court has stated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

ANALYSIS

Rejection of claims 1, 3, 5-10, 12-17, and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over Abram

Independent claims 1 and 24 and Dependent claims 3, 5-10, 12-17, 23, and 25

Appellant’s arguments have persuaded us of error in the Examiner’s rejection of independent claims 1 and 24 and dependent claims 3, 5-10, 12-17, 23, and 25. Independent claim 1 recites “selectively disabling one or more of the colors, while not disabling all of the colors besides black, of the printer to insure little or none of the one or more disabled colors is printed

by the printer.” Independent claim 24 recites similar limitations. Dependent claims 3, 5-10, and 12-17 depend upon claim 1 and dependent claim 25 depends upon claim 24 and, therefore, also recites similar limitations to their independent claims. Appellant argues that Abrams does not selectively disable any of the colors. App. Br. 5; Reply Br. 4. We agree.

Abram discloses a programmable or fixed palette of colors that is assigned to an image area of the coloring book image. FF 6. In order to create a color-by-numbers coloring book image, an index number assigned to a corresponding sample color and the color itself may be printed with the coloring book image. FF 6. The Examiner finds that since the palette is programmable, Abram discloses that a user selects colors to be printed and/or not printed on the storyboard. Ans. 16. The Examiner interprets the ability to select colors to be printed as “abling” the colors and disabling all the other colors. Ans. 16. We disagree. The ability to select colors to be printed is not the same as selectively disabling colors. “Selectively disabling” a color implies a specific intent by a user not to print a particular color, just as selectively printing a color requires specific intent by a user to print a particular color. Abram discloses that sample colors are chosen for the palette. FF 6. While these sample colors may be chosen and printed, nowhere in Abrams does it discuss or disclose preventing other colors from being printed by the printer. Since Abram does not disclose a specific intent not to print a color, we will not sustain the Examiner’s rejection of claims 1, 3, 5-10, 12-17, and 23-25.

Independent claim 20

Appellant’s arguments have not persuaded us of error in the Examiner’s rejection of claim 20. Claim 20 recites, in the preamble, “[a]

method of producing a work of art using a thermal ink-jet printer having an active black ink cartridge and at least one active primary color ink cartridge.” Appellant argues that Abram does not disclose a thermal inkjet printer with black and color cartridges. App. Br. 7. The Examiner does not give any patentable weight to this portion of the claim since it is in the preamble and the process steps or structural limitations in the body of the claim stand alone. Ans. 18. As a result, this limitation need not be found in prior art. However, the Examiner finds that inkjet printing has been used for many years and is therefore well known in the art. Ans. 18. In addition, Appellant’s own Specification admits that inkjet and laser printers that print more than one color are well known. FF 1. Thus, we do not find Appellant’s arguments to be persuasive.

Claim 20 additionally recites “(b) removing the active black ink cartridge from the printer, or controlling the printer with software, to disable from about 80-100% the capability of the printer to print black and near black while not significantly disturbing operation of the active primary colors cartridge; [and] (c) with the printer, printing a substantially accurate representation of the image, but without about 80-100% of the black and near black, onto a substrate of paper or canvas.” Appellant argues that not printing black for line art is contrary to the teachings of Abram and that Abram does not disclose printing a substantially accurate representation of the image without 80-100% of the black and near black. App. Br. 7-8. We disagree. Abram teaches rendering a line-art image from a digital image and formatting and printing a coloring book image from the line-art image. FF 5. Abram does not preclude the ability to print the coloring book image that is formatted from the line-art image in a different color other than black.

Therefore, Abram does not preclude disabling 100% the capability of the printer to print black and near black. As a result, Appellant's arguments are not found to be persuasive and we sustain the Examiner's rejection of claim 20.

Dependent claim 21

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 21. Claim 21 contains similar limitations and is dependent upon claim 20. Appellant presents many of the same arguments discussed above with respect to claim 20. App. Br. 9. Therefore, we do not find Appellant's arguments to be persuasive.

Appellant's additional argument that Abram does not disclose applying acrylic paint to portions of the substrate is also not persuasive. App. Br. 9. While it is true that Abram does not specifically disclose applying acrylic paint to portions of the substrate, Appellant has indicated in Appellant's own Specification that there are several known art techniques to apply color and texture to produce a final piece of art. FF 2. For instance, Appellant indicates that using a paint brush to apply paint, using a palette knife to apply paint or wax, or incorporating foreign materials into the artwork are well known. FF 2. Therefore, using a well known method of applying acrylic paint to Abram's coloring book image is nothing more than using a known art technique to add color and texture to a coloring book. As a result, Appellant's argument is not found to be persuasive and we sustain the Examiner's rejection of claim 21.

Dependent claim 22

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 22. Claim 22 contains similar limitations and is dependent upon claim 20. Appellant presents many of the same arguments discussed above with respect to claim 20. App. Br. 9. Therefore, we do not find Appellant's arguments to be persuasive.

Appellant's additional argument that Abram does not disclose a substrate that is at least thirty pound matte paper is also not persuasive. App. Br. 9; Reply Br. 6. While it is true that Abram does not specifically disclose thirty pound matte paper, Appellant has indicated in Appellant's own Specification that thirty pound matte finish photo paper is known to be used to receive and retain ink dispensed by printers. FF 3. Therefore, using well known thirty pound matte paper to print Abram's coloring book image is nothing more than using a known substrate for its known purpose of receiving and retaining ink. As a result, Appellant's argument is not found to be persuasive and we sustain the Examiner's rejection of claim 22.

*Rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over
Abram in view of Kohno*

Appellant's arguments have persuaded us of error in the Examiner's rejection of claim 11. Claim 11 ultimately depends upon claim 1 and contains similar limitations discussed *supra* with respect to claim 1. The Examiner has not found that the additional teachings of Kohno make up for the deficiencies noted in the rejection of claim 1. Therefore, we sustain the Examiner's rejection of claim 11 for the reasons discussed *supra* with respect to claim 1.

SUMMARY

The Examiner's decision to reject claims 1, 3, 5-10, 12-17, and 23 under 35 U.S.C. § 103(a) as being unpatentable over Abram is reversed.

The Examiner's decision to reject claims 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Abram is affirmed.

The Examiner's decision to reject claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Abram in view of Kohno is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a)(1)(iv).

Appeal 2009-004151
Application 10/740,486

AFFIRMED-IN-PART

ELD

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